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The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH B. BRICK

Appeal No. 2000-1794
Application 08/901,171

HEARD: May 15, 2001

Before ABRAMS, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Ralph B. Brick appeals from the final rejection of claims 1 through 13, all of the claims pending in the application.

THE INVENTION

In general, the invention relates to a well known type of packaging assembly comprising a wrapping material for covering an article and an elongated tape having a hidden portion disposed internally between the article and the wrapping material and a visible gripping portion disposed externally of

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the wrapped article to facilitate removal of the wrapping material from the article. In the appellant's package assembly, "the visible gripping portion of the elongated tape [has] a first message associated therewith and the hidden portion of the elongated tape [has] a second message associated therewith intellectually compatible with the first message which becomes available for viewing upon unwrapping the wrapping material from the article" (specification, page 3). A copy of claims 1 through 13 appears in the appendix to the appellant's main brief (Paper No. 18).

THE REFERENCES

The references relied on by the examiner to support the final rejection are:

Lenkoff	3,826,499	Jul. 30, 1974
Hill	5,645,300	Jul. 8, 1997

"Hershey's Kisses chocolates,"
<http://www.hersheys.com/totally/product/kisses> (downloaded January 12, 1999, 12:46PM) (Hersheys.com)¹

THE REJECTIONS

¹ Although the download date of this reference is subsequent to the July 28, 1997 filing date of the instant application, it is not disputed that the subject matter discussed in the reference, particularly the Hershey's Kisses packaging arrangement, is prior art with respect to the appellant's invention.

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Claims 1 through 11 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1 through 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hersheys.com.

Claims 10 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hersheys.com in view of Lenkoff.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hill.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 18 and 20) and to the examiner's final rejection and answer (Paper Nos. 14 and 19) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The examiner's refusal to enter the amendment filed subsequent to final rejection

On March 28, 2000, the appellant filed an amendment (Paper No. 15) subsequent to final rejection which has been refused entry by the examiner (see the advisory action dated April 5,

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2000, Paper No. 16). The appellant (see pages 2 and 3 in the reply brief) suggests that this Board has the authority to remand the application to the examiner with instructions to enter the amendment, and seemingly urges us to do so. It is well settled, however, that the refusal of an examiner to enter an amendment after final rejection is a matter of discretion reviewable by petition to the Commissioner rather than by appeal to this Board. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). Accordingly, we shall not review or further discuss this matter.

II. The 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 11 and 13

The examiner considers claims 1 through 11 and 13 to be indefinite because

[i]n claims 1-11 and 13 the use of the recitation "adapted to be" renders the claim indefinite. Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re [Hutchison], 69 USPQ 138. In claim 1, lines 6 and 7, the recitation "a wrapper hidden portion . . . within the inner surface of said wrapping material . . ." is not clear [final rejection, page 2].

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In further explanation of this position, the examiner states that

the use of the language "adapted to be" renders the claim indefinite because, for example, Appellant is not positively claiming the visible gripping portion being positioned externally of the wrapping material. The recitation "a wrapper hidden . . . within the inner surface of the wrapping material . . ." is not clear to the Examiner. The Examiner does not understand how the wrapper hidden portion is nested within the inner surface of said wrapping material. Is the Appellant referring to the elongated single, unitary tape as

being the "wrapper hidden portion"? How can the wrapper which is used to completely wrap the outer surface of the article, as claimed, hide within itself? [answer, page 4].

The examiner's determination that claims 1 through 11 and 13 are indefinite for these reasons is not well taken. The "adapted to be" terminology in the claims constitutes functional language which merely defines the claimed packaging assembly elements in terms of what they are intended to do. Contrary to the position taken by the examiner, there is nothing intrinsically wrong with the use of this technique in drafting a patent claim. See In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971). The examiner's additional concern with the recitation in claim 1 of the "wrapper hidden

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portion" is also unfounded. When claim 1 is read, as it is required to be, in light of the underlying specification, it is reasonably clear that the "wrapper hidden portion" refers to a part of the elongated tape which is adapted to be nested within the inner surface of the wrapping material.

Thus, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 11 and 13.

III. The 35 U.S.C. § 103(a) rejection of claims 1 through 9 and 11 as being unpatentable over Hersheys.com

Hersheys.com discusses the familiar package for a Hershey's Kisses chocolate. It is not disputed that this package comprises a foil wrapper completely enclosing the chocolate and an elongated tape having a hidden portion lying between the wrapper and the chocolate and a visible gripping portion extending out of the wrapper and bearing the word "KISSES."

As conceded by the examiner (see page 3 in the final rejection), Hersheys.com does not respond to the limitations in independent claim 1, or the corresponding limitations in independent claim 11, requiring the visible gripping portion of the tape to have printed thereon a first response solicitive message and the spaced wrapper hidden portion of the tape to

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have printed thereon a second differing and responsive completing portion of the message intellectually compatible with and functionally pertaining to and completing the message. The examiner nonetheless concludes that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the necessary printed matter on the elongated tape for advertisement purposes as necessitated by the end user since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of packaging assembly

does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the elongated tape which is required for patentability [final rejection, pages 3 and 4].

Differences between an invention and the prior art cannot be ignored merely because those differences reside in the content of printed matter. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Where the printed

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matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight. What is required is the existence of differences between the claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Id.

In the present case, claims 1 and 11 do indeed recite a specific functional relationship between the response solicitive and responsive "printed matter" and the tape "substrate," i.e.

that the response solicitive matter be printed on the visible gripping portion of the tape and that the responsive matter be printed on the spaced hidden portion of the tape. The examiner's conclusion that it would have been obvious to

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provide the Hersheys.com tape with these features is completely devoid of factual support. Hence, the examiner's ultimate conclusion that the differences between the subject matter recited in claims 1 and 11 and the applied prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art must fall.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 and 11, or of claims 2 through 9 which depend from claim 1, as being unpatentable over Hersheys.com.

IV. The 35 U.S.C. § 103(a) rejection of claims 10 and 13 as being unpatentable over Hersheys.com in view of Lenkoff

Claims 10 and 13 depend, either directly or indirectly, from independent claims 1 and 11, respectively. Suffice to say that Lenkoff's disclosure of games having marking sheets printed with invisible ink and marking pens designed to make such printing visible does not cure the above noted deficiencies of Hersheys.com with respect to the subject matter recited in parent claims 1 and 11.

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Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 10 and 13 as being unpatentable over Hersheys.com in view of Lenkoff.

V. The 35 U.S.C. § 103(a) rejection of claim 12 as being unpatentable over Hill

Independent claim 12 recites an elongated tape and is similar to independent claims 1 and 11 in that it requires the tape to include opposed, i.e., opposite, extremities having printed thereon functionally compatible message portions which are response solicitive and responsive, respectively.

Hill discloses a label/wrapper composed of a flexible elongated strip of paper or plastic adapted to be wrapped around packages for food or other products. The label/wrapper may carry printed indicia relating to trademarks, logos, product names, cooking information, product coupons, recipes and the like.

In essence, the examiner (see page 5 in the final rejection) concedes Hill to be unresponsive to the printed matter limitations in claim 12 in the same sense that Hersheys.com is

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unresponsive to the printed matter limitations in claims 1 and 11. The examiner's position that these differences do not constitute patentable distinctions is substantively identical to that advanced with respect to claims 1 and 11 and the Hersheys.com reference and is unpersuasive for the same reasons.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 12 as being unpatentable over Hill.

VI. New rejection

The following new rejection is entered pursuant to 37 CFR § 1.196(b).

Claims 1, 11 and 13, and claims 2 through 10 which depend from claim 1, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Independent claim 1 is unclear as to the relationship between the "single message" and the subsequently recited "first response solicitive message." Amending the recitation of the "first response solicitive message" to read as --a first

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response solicitive portion of said message-- would overcome this problem.

Independent claim 11 is similarly unclear as to the relationship between the "single message" and the subsequently recited message/message portion limitations. Moreover, these subsequently recited message/message portion limitations are inconsistent in and of themselves. For example, the terms "said first portion" and "said written intellectually response solicitive message" lack a proper antecedent basis.

Finally, claim 13 is unclear in that the preambular recitation of "The elongated tape of Claim 11" and the recitation of "said messages" lack a proper antecedent basis.

SUMMARY

The decision of the examiner to reject claims 1 through 13 is reversed; and a new rejection of claims 1 through 11 and 13 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37

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CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b).

NEAL E. ABRAMS

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